

REMARKS

This Amendment and Response is being submitted in response to the Office Action mailed December 1, 2003. Claims 1-7 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Claims 1-7 also stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Claims 1-7 also stand rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Applicant respectfully traverses the Examiner's rejections.

Applicant has amended claim 1. No new matter has been added in the Amendment. Support for the Amendment may be found in the Specification and the claims as originally filed. Reconsideration of the claims is respectfully requested in light of the amendment above and the remarks below.

I. Non-elected Claims

Applicant previously elected claims 1-7 with traverse. Applicant has cancelled claims 8-24 in this Amendment. Applicant reserves the rights to pursue these claims in a continuation or divisional application.

II, Drawings

The drawings are objected to. Applicant submits herewith corrected drawings. Applicant respectfully requests that the objection to the drawings be withdrawn.

III. Abstract

The abstract of the disclosure is objected to because the length exceeds 150 characters. Applicant has amended the abstract. Applicant respectfully requests that the objection to the abstract be withdrawn.

IV. Claims 1-7, §112, First Paragraph

Claims 1-7 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. The Examiner states that Applicant does not appear to adequately define the claimed limitation instance data or an instance.

For clarity, and to avoid redundancy, Applicant has amended claim 1, deleting the term “data” from the preamble of the claim.

35 U.S.C. § 112 states, in part, “[t]he specification shall contain a written description of the invention...in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains...to make and use the same.” Applicant has described the term “instance” so as to enable person of skill in the art to make and use the invention. The claim term “instance” is adequately defined in the Specification. For example, the definition of the claim term “instance” begins on page 22, “An instance comprises a data point, which represents a specific type of object that possesses certain characteristics or attributes,” continues on page 23, and the term is used and supported throughout the specification.

Thus, the specification complies with the written description requirement, and Applicant respectfully requests that the Examiner withdraw the rejection of claim 1-7 under 35 U.S.C. § 112, first paragraph.

V. Claims 1-7, §112, Second Paragraph

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. The Examiner states in the Office Action “[r]egarding claim 1, the following limitation is vague: ‘classifying instance data’ [note claim 1 line 1] and an instance [claim 1 line 2].”

The term “classifying instance data” is in the preamble of claim 1 and is not a limitation. A preamble is not limiting unless the preamble is necessary to give “life, meaning, and vitality to the claim.” *Catalina Mktg., Int’l v. Coolsavings.com*, 289 F.3d 801, 808 (Fed. Cir. 2002). The term “classifying instance data” is not necessary to give “life, meaning, and vitality to the claim.” Accordingly, the term “instance data” is not a limitation. Further, as mentioned above, Applicant has amended claim 1 to delete the term “data.”

The MPEP states that “[t]he essential inquiry pertaining to this [35 U.S.C. § 112, second paragraph] requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” M.P.E.P. § 2173.02. Respectfully, claim 1 sets out the subject matter claimed with a reasonable degree of clarity and particularity. Applicant respectfully requests that the Examiner withdraw the rejection of claim 1-7 under 35 U.S.C. § 112, second paragraph.

VI. Claims 1-7, § 101

Claims 1-7 stand rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. The Examiner states, “...the claim does not define a useful machine or manufacture by identifying the physical structure of the machine or manufacture.” Office Action, page 5.

According to 35 U.S.C. § 101, “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” Respectfully, claims 1-7 fall squarely within 35 U.S.C. § 101. The scope of patentable subject matter under 35 U.S.C. § 101 is the same regardless of the form of the claim, machine or process. *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q.2d 1447, 1451 (Fed. Cir. 1999). Indeed, the claimed process produces a “useful, tangible, and concrete result” in the form of, for example, classification. See, *Id.* at 1359, citing *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998), cert. denied, 525 U.S. 1093, 119 S.Ct. 851, 142 L.Ed.2d 704 (1999). Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 1-7 under 35 U.S.C. § 101.

VII. Prior Art Made of Record and Not Relied On

In section 12, the Office lists “[t]he prior art made of record and not relied upon [that] is considered pertinent to applicant's disclosure.” Office Action, page 5. Applicant respectfully disagrees with whether these references are relevant or pertinent or prior art, and respectfully

reserves the right to present such arguments and other material should the Examiner maintain rejection of Applicant's claims, based upon the references listed or otherwise.


VIII. Conclusion

Applicants respectfully submit that claims 46-72 are allowable. A favorable Office Action is respectfully solicited.

Should the Examiner have any comments, questions or suggestions of a nature necessary to expedite the prosecution of the application, or to place the case in condition for allowance, the Examiner is courteously requested to telephone the undersigned at the number listed below.

Respectfully submitted,

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